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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,271	01/22/2001	Takashi Sako	AA33/VB	5065

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/744,271	SAKO ET AL.	
	Examiner	Art Unit	
	D. L. Jones	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGMENTS

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/19/06 has been entered.

Note #1: The Examiner acknowledges receipt of the amendment filed 6/19/06 wherein claims 1 and 10 are amended.

Note #2: Claims 1-10 are pending.

2. The Examiner acknowledges receipt of the abstract and specification filed 6/19/06 and the declaration filed under 37 CFR 1.132 on 6/19/06.

DECLARATION

3. The declaration by Takashi Sako filed under 37 CFR 1.132 on 6/19/06 is acknowledged. While the declaration is found persuasive as it relates to the specific amphoteric conditioning polymer compound, aqueous carrier compound, humectant compound, and copolymer compound combination specific for Examples A and B as set forth in the declaration, the declaration is not found persuasive in regards to the general teachings of any amphoteric conditioning polymer, aqueous carrier, humectant comprising a polyethylene glycol having a molecular weight of up to 1000, and

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copolymer combination. Also, it is noted that in the modified rejection above, Trinh et al (US Patent No. 5,540,853, column 15, lines 25-27) teaches propylene glycol, polypropylene glycol, and polyethylene glycol as equivalents.

RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS

4. The Applicant's arguments and/or amendment filed 6/19/06 to the rejection of claims 1-10 made by the Examiner under 35 USC 103 are moot in view of the new grounds of rejection below.

103 Rejection

Claims 1-10 are rejected under 35 USC 103(a) as being unpatentable over Karlen et al (US Patent No. 6,004,545) in view of Trinh et al (US Patent No. 5,540,853), Hitchen (US Patent No. 6,106,816, Kang et al (WO 97/23194), and Rath et al (US Pat No. 5,993,792), and in further view of Papantoniou (US Patent No. 4,048,301).

Applicant's arguments may be summarized as follows: (1) Karlen et al fail to disclose the use of a humectant comprising a polyethylene glycol having a molecular weight of up to about 1000 as set forth in the instant invention. (2) Kang et al disclose compositions comprising polypropylene glycol, not polyethylene glycol as in the instant invention. (3) Applicant's have surprising found that a humectant comprising polyethylene glycol having a molecular weight of up to about 1000 provides less stickiness when compared to low molecular weight humectants such as propylene glycol. (4). Applicant has provided a declaration under 37 CFR 1.132 to indicate that the use of polyethylene glycol is beneficial in creating a non-sticky feel without tackiness

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on the hands. (4) In regards to Hitchen Applicant concluded that amphoteric conditioning polymers have better compatibility with the acrylic acid/alky acrylate copolymers that do the cationic polymers such as Merquat 100 and Merquat 550 disclosed by Hitchen.

First, for clarification of the record, the teachings of Karlen et al should be clarified. Karlen et al disclose a hair composition that contains copolymers of carboxylic acid (e.g., Carbopol-1342, column 6, line 62); and amphoteric conditioning polymer (e.g., Merquat Plus 3300, columns 7-8, bridging paragraph); an aqueous carrier (e.g., water, column 8, line 58); silicon compounds (column 6, lines 11-13); viscosity modifiers (e.g., thickeners, diluents, or thinning agents, column 8, lines 28 and 31; column 7, lines 9-10); visible particles (e.g., guar, column 8, line 49: this is one of the visible particles disclosed in Applicant's specification, page 16, line 18); UV absorbers (e.g., light protective agents, column 8, lines 33-34); optical brighteners (e.g., pearlescence inducing agents and luster imparting agents, column 8, lines 21 and 34); and herbal extracts and conditioning agents (e.g., jojoba oil or fruit wax, column 8, lines 54-57). Also, Karlen et al disclose that one may have propylene glycol present (columns 5-6, bridging paragraph, especially, column 6, line 3). Thus, while Karlen et al disclose a humectant, propylene glycol, the reference does not specifically disclose that the humectant may be polyethylene glycol.

Secondly, it should be noted that Hitchen refers to polyethylene glycol as a conditioning agent in column 4, lines 35-65, specifically, lines 64-65). The specific reference by Hitchen to polyethylene glycol (US Patent No. 4,048,301) is a patented

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document to Papantoniou. In particular, Papantoniou discloses cosmetic hair compositions that comprise polyethylene glycol. The compositions impart luster and softness to the hair and also facilitate the combing and untangling of the hair (column 1, lines 6-17). In addition, Papantoniou discloses that the compositions have from 2 to 50 percent of polyethylene glycol and that the polyethylene glycol general has a molecular weight between 200 and several million, but, preferably, between 300 and 30,000 (column 1, lines 30-33 and 44-50).

In summary, in regards to the assertion that the prior art does not render obvious incorporating polyethylene glycol into the cosmetic composition being claimed by Applicant, the arguments are not found persuasive because, it is well known in the art as indicated by Hitchen and Papantoniou to incorporate polyethylene glycol in cosmetic compositions to aid in conditioning hair. Furthermore, as indicated by Papantoniou (column 1, lines 44-55) that the polyethylene glycol used in producing the graft cationic copolymer results in very desirable results when the amount of the graft cationic polymer in the composition ranges between 0.1 and 5 weight percent of the composition. Thus, it is the Examiner's position that the art provides motivation to incorporate polyethylene glycol into a cosmetic composition useful for hair conditioning. Also, more importantly, Trinh et al disclose compositions including cleansing and/or cosmetic compositions wherein a component that may be added to the composition may be selected from propylene glycol, polypropylene glycol, or polyethylene glycol (column 15, lines 25-27). This reference is made of record because it discloses that in the cosmetic art propylene glycol, polypropylene glycol, and polyethylene glycol are

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equivalents of one another. Thus, a skilled practitioner in the art would recognize and be motivated to interchange propylene glycol or polypropylene glycol for polyethylene in the art as humectants.

ELECTION BY ORIGINAL PRESENTATION

5. Newly submitted claims 1-10 (as it relates to the polymer present in the composition) are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons. While 37 CFR 1.114 provides for continued examination of an application at the request of Applicant, the request for continued examination (RCE) is not the basis for obtaining continued examination on the examination of claims that are independent and distinct from the claims previously claimed and examined as a matter of right. In other words, Applicant cannot switch inventions. Thus, the claims of the instant invention will be examined based on the structure of the acrylic acid/alkyl acrylate copolymer having the formula as set forth in the originally filed claims. Hence, it is assumed that the formula on page 4 of the specification and as set forth in the previous claims is embraced by the functional language in the pending claims. As a result, the search has not been extended beyond that formula as set forth on page 4 and examined previously.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-10 are examined as having the formula on page 4 and which is that examined in previous office actions.

DOUBLE PATENTING REJECTION

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 1-5 and 8-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 6, and 8 of U.S. Patent No. 6,767,875 in view of Trinh et al (US Patent No. 5,540,853).

Trinh et al disclose compositions including cleansing and/or cosmetic compositions wherein a component that may be added to the composition may be selected from propylene glycol, polypropylene glycol, or polyethylene glycol (column 15, lines 25-27).

Both sets of claims (Applicant's and US Patent No. 6,767,875) are directed to compositions comprising a carboxylic acid/carboxylate copolymer, an aqueous carrier, an amphoteric polymer, and a humectant/moisturizing agent. The claims differ in that the claims of the instant invention read on a polyethylene glycol humectant having a molecular weight of up to about 1000 while the patented invention reads on a composition wherein the moisturizing agent is polypropylene glycol. First, it would have been obvious to one of ordinary skill in the art at the time the invention was made that a homologous series is a family of chemical related compounds wherein one member varies from another by a CH₂ group, as in polyethylene glycol and polypropylene glycol. Thus, one would not expect that the compounds would behave similarly, if not the same since members of a homologous series have similar, if not the same, characteristics. Alternatively, a skilled practitioner in the art using the teachings of Trinh et al would recognize that polypropylene glycol and polyethylene glycol are often taught as equivalents as set forth in Trinh et al, column 14, line 60. As a result, a skilled practitioner in the art would be motivated to interchange polypropylene glycol with

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polyethylene glycol, and vice versa without drastically altering the overall properties of the composition.

112 SECOND PARAGRAPH REJECTIONS

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-9: Independent claim 1 is ambiguous because it is unclear what Applicant intends by the phrase 'up to about 1000'. The phrase is indefinite because there is no lower limit set forth. As a result, one may have no humectant present. In other words, the phrase as written would encompass a molecular weight of zero which would mean that the polyethylene glycol is absent from the mixture. Since, independent claim 1 is ambiguous, all claims depending thereupon (claims 2-9) are also ambiguous.

Claim 2: The claim as written is ambiguous because it discloses that the composition further comprises a humectant. In particular, the claim is confusing because it depends from claim 1 which discloses that a polyethylene glycol humectant is present.


Claim 4: The claim as written is ambiguous because it discloses that an additional viscosity modifier is present. However, claim 4 depends from claim 1 which does not require the presence of a viscosity modifier.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1618

September 1, 2006